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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,545	03/01/2004	Joseph W. Hundley	P09522US02/BAS	5732

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EXAMINER	
TOOMER, CEPHIA D	
ART UNIT	PAPER NUMBER
1797	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/790,545	HUNDLEY, JOSEPH W.	
	Examiner	Art Unit	
	Cephia D. Toomer	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/9/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the amendment filed July 3, 2008.

The rejection of the claims under 35 U.S.C. 112, second paragraph is withdrawn in view of the amendment to the claims.

The rejections of the claims over Stutz and Groszek are withdrawn in view of the amendment to the claims.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 9, 11-15, 19 and 20 of copending Application No. 11/214,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition

and methods set forth in the present invention encompasses those of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,860,911. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions and methods of the present invention encompass those of the patent.

4. Applicant argues that the present invention includes ammonia and ammonia-like compounds and that such compounds are distinguishable from the claims of U.S. Patent 6,860,911.

The examiner respectfully disagrees. In the patent, a base is required to neutralize the acid. Ammonia and ammonia-like compounds are bases.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Franke (US 4,741,278).

Franke teaches a solid carbonaceous fuel containing 0.1 to 5 wt % of iron oxide (see abstract). Franke teaches that the fuel has a reduced tendency to form NO_x on combustion (see col. 1, lines 55-57). The additive is present in the fuel in a finely divided or finely dispersed form (see col. 2, lines 31-33). The coal may be coal dust (see col. 2, lines 21-23).

Accordingly, Franke teaching all of the limitations of the claims anticipates the claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 22, 25, 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franke (US 4,741,278).

Franke has been discussed above. Franke fails to teach that the coal and NO_x reduction agent are ground together. However, no unobviousness is seen in this difference because it is well settled that combining two step into one does not avoid obviousness where the processes are substantially identical or equivalent in function, manner and results. *General Foods Corp. v. Perk Foods Co.* (DC NIll 1968) (157

USPQ 14); *Malignani v. Germania Electric Lamp Co.*, 169 F. 299, 301 (D.N.J. 1909*);* *Matrix Contrast Corp. v. George Kellar*, 34 F.2d 510, 512, 2 USPQ 400, 402-403 (E.D.N.Y 1929); *Hammerschlag Mfg. Co. v. Bancroft*, 32 F. 585, 589 (N.D.Ill.1887); *Procter & Gamble Mfg. Co. v. Refining*, 135 F.2d 900, 909, 57 USPQ 505, 513-514 (4th Cir. 1943); *Matherson-Selig Co. v. Carl Gorr Color Gard, Inc.*, 154 USPQ 265, 276 (N.D.Ill.1967).

Franke also fails to teach that the coal is bituminous coal. However, no unobviousness is seen in this difference because the general teaching of coal encompasses bituminous coal, in the absence of evidence to the contrary.

1. Claims 1, 3, 7, 10, 13-15, and 18-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US 20050202989).

Wilson teaches a cleaning composition comprising 0.1 to 99 % by weight of an alkali selected from ammonium hydroxide and amines; 0.1-30% of a surfactant selected from fatty acids; 0.2-95% of a builder such as urea; and water (see claim 2 and Table 2). Wilson does not teach applicant's intended use however; intended use is given no patentable weight in claims that are directed to the composition per se.

Wilson does not specifically exemplify a composition wherein all of the above specific compounds are present. However, Wilson teaches in his very narrow Markush groups that the above compounds are within the scope of his invention.

2. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues that Franke does not disclose a chemical change agent and that Franke teaches away from the claim invention because there are several process steps in the process of Franke that would not be feasible in the coal industry.

Applicant's claims are open and do not exclude the additional process steps of Franke. Furthermore, claim 28 is not limited to coal. Applicant is claiming a combustible material which reads on far more materials than coal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cephia D. Toomer/
Primary Examiner
Art Unit 1797

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